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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,431	08/29/2001	Taisei Matsumoto	NIT-297	7065

7590 12/27/2005

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EXAMINER	
REILLY, SEAN M	

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/940,431	MATSUMOTO, TAISEI	
	Examiner	Art Unit	
	Sean Reilly	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22 and 40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on 9/28/2005. Claims 22 and 42 are presented for further examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. Regarding claim 40, Applicant claims multiple "units", which are software per se. A software program which is not tangibly embodied on a computer readable medium, is merely a manipulation of abstract ideas.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 22 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki (Japan Patent Application Publication 11-338797) and Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi).

4. Regarding claims 22 and 40, Toshiaki disclosed an electronic mail management method comprising the steps of:

- receiving an electronic mail sent from an electronic mail sending source terminal to an electronic mail recipient having an electronic mail destination terminal through a first communication means (¶ 4);
- storing said electronic mail received (e.g. storage in mailbox MBX, ¶ 5); and
- posting a message to said recipient to urge opening of an unopened electronic mail (transmission to urgent destination) at a communication terminal that is different from said electronic mail destination terminal (urgent destination) through a second communication means which is different from said first communication means, when said stored mail is not opened by said electronic mail recipient within a first predetermined time (unopened time limit) (see inter alia, ¶s 4 and 7).

Toshiaki failed to specifically recite posting the presence of said unopened electronic mail to said electronic mail sending source terminal if, after the posting of the presence of said unopened electronic mail to said communication terminal through said second communication. Nonetheless alerting the sender of an e-mail that the e-mail hasn't been read after a given period of time was well known in the art at the time of the invention, as evidenced by Kenichi. In an analogous art Kenichi disclosed an email system where the sender of an email is alerted to the presence of an unopened email after a period of time (see ¶ 11). It would have be advantageous to a person having ordinary skill in the art at the time of the invention to incorporate the sender unopened notification system disclosed by Kenichi within Toshiaki's system, since Kenichi

disclosed alerting the sender of unopened email relieves the sender from the burden of contacting the recipient via other means when the sender has already opened the email, thus harnessing the advantage of e-mail (¶ 05).

Response to Arguments

5. In response to Applicant's request for reconsideration filed on 9/28/2005, the following factual arguments are noted:

a. Claim 40 is statutory since a storing unit is recited in the claim language.

b. Toshiaki failed to disclose notifying both the recipient and sender of an unopened email.

In considering (a), Examiner respectfully disagrees with Applicant's argument. Examiner does not equate the storing unit recited in claim 40 to be an actual storage unit. Rather, the storing unit is interpreted to be a software component that merely completes the act of storing (i.e. issues a command to store data). Applicant fails to claim a single piece of hardware in the recitations of claim 40. Each claimed *unit* is merely a software component. Accordingly claim 40 is software per se. A software program which is not tangibly embodied on a computer readable medium, is merely a manipulation of abstract ideas and non-statutory.

In considering (b), Examiner respectfully disagrees with Applicant's argument. Examiner agrees that Toshiaki does not disclose both the steps of notifying a *recipient* and *sender* of an unopened message. Accordingly Examiner applied the Kenichi reference to cure

this deficiency. Applicant asserts that "the deficiencies in Toshiaki are not overcome by resorting to the remaining references" (Applicant response 8/31/2005 pg 6). However, Applicant fails to even mention the Kenichi reference or further to provide any rationale as to how applicant arrives at this conclusion. Applicant's arguments amount to nothing more than a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Accordingly Applicant's arguments fail to comply with 37 CFR 1.111(b).

Conclusion

15. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

16. This office action is made **NON-FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/20/2005

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